REMARKS

This amendment responds to the Office Action mailed August 11, 2004. Claims 23-27 have been amended to correct certain informalities noted by the Examiner. Claims 28-35, 104-116, 134-139, 146-152 and 160-177 have been amended to clarify that the methods set forth therein are conducted by computer. Claims 1, 28-35, 48, 62-64, 72, 104-112, 117, 131-134, 140, 146, 153, 160, and 175-177 have been amended to further define the invention.

CLAIMS 23-27 ARE NO LONGER OBJECTIONABLE

The Examiner objected to claims 23-27 due to certain informalities. The Applicant thanks the Examiner for her diligence and has amended these claims in accordance with the Examiner's remarks. Reconsideration and withdrawal of the objection to claims 23-27 is therefore respectfully requested.

CLAIMS 28-35, 104-116, 134-139, 146-152 AND 160-177 SATISFY 35 U.S.C. §101

The Examiner rejected claims 28-35, 104-116, 134-139, 146-152 and 160-177 under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Examiner contends that these claims are directed to non-statutory subject matter because it is not clear whether the heart of the invention utilizes technology. While the Applicant respectfully disagrees with the Examiner's contention, in order to expedite issuance of a patent, the Applicant has amended these claims in accordance with the Examiner's remarks to indicate that at least the methods are performed by a computer to. Therefore, the Applicant respectfully submits that claims 28-35, 104-116, 134-139, 146-152 and 160-177 satisfy 35 U.S.C. §101 and reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

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CLAIMS 1-177 ARE PATENTABLE OVER CHISHOLM

The Examiner rejected claims 1-177 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,400,248 to Chishom [hereinafter "Chisholm"]. Essentially, the Examiner contends that Chisholm discloses all of the elements of the claims at issue, except for teaching that "a user is voting shares *per se* in a corporate voting." The Examiner then contends it would have been obvious to apply Chisholm to corporate voting. The Applicant respectfully disagrees with the Examiner's characterization of this reference vis-à-vis the claims at issue.

Each of the independent claims of claims 1-177 includes *inter alia* various actions involving "*preferences* regarding how to vote a user's shares." These preferences are used to determine how to vote a user's share in *future* corporate voting actions. Once entered, these preferences enable a computer to automatically vote the user's shares in a corporate voting action that did not necessarily exist when the user entered his or her preferences.

Chisholm discloses a system in which the user can enter *conditional* votes. For example, vote "YES" if person A votes "YES." However, these are still actual votes entered in direct response to a proposition.

In contrast, the computer-implemented method of the present invention enables a user to enter in advance of any corporate voting, *preferences* (NOT CONDITIONAL VOTES), as to how the user wishes to vote in subsequent corporate voting actions. Thus, the system then consults the user's preferences upon initiation of a corporate voting action and then creates a vote (not a conditional vote) in accordance with the user's preferences. This enables a user to be free of the burdens of processing multiple corporate voting actions for every type of share the user holds in his or her portfolio. A user can be overwhelmed in the case where a user owns a large diverse portfolio, such as may occur in the portfolio trading system of Folio*fn*. As stated in the specification, "The present invention enables users to specify their preferences once and then continue to vote in corporate actions with little or no input. The resulting simplicity enables shareholders to properly manage and own shares in a relatively vast number of different corporations." In short, a conditional vote is not a preference as a

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preference can exist prior to a proposition, whereas a conditional vote does not exist until presented with a proposition on which to vote.

Claims 1, 28, 29, 30, 31, 32, 33, 34, 35, 48, 62, 63, 64, 72, 104, 105, 106, 107, 108, 109, 110, 111, 112, 117, 131, 132, 133, 134, 140, 146, 153, 160, 175, 176 and 177 have been amended to clarify the invention in that preferences are established prior to a corporate vote, and then used in one or more subsequent corporate votes. Thus, the claimed methods and apparatuses recited in claims 1-177 are not obvious in view of Chisholm because Chisholm cannot address the problem of voting in multiple corporate actions over multiple securities. In the system set forth by Chisholm, a user would still be required to enter a conditional vote for each and every corporate action for a given security in his or her portfolio and for each and every security in his or her portfolio.

In short, the Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because Chisholm does not disclose or suggest all elements of Applicant's rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by Chisholm either taken alone or in any combination with any other references. Reconsideration and withdrawal of the rejection of these claims is therefore respectfully requested.

CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowance.

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

FEES

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any

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overpayment to the deposit account of Mayer Fortkort & Williams PC, Deposit Account No. 50-1047.

Respectfully submitted,

By _____   Date: <u>November 11, 2004</u>
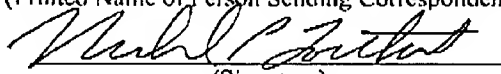Michael P. Fortkort (Reg. No. 35,141)

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    Please direct telephone calls to:
    Michael P. Fortkort
    703-435-9390

> **Certificate of Facsimile Transmission**
> I hereby certify that this correspondence and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 703-872-9326 on November 11, 2004.
>
> <u>Michael P. Fortkort</u>
> (Printed Name of Person Sending Correspondence)
>
> _____
> (Signature)

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